



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

C

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,412	04/03/2001	Grant Hood	071235.0113	1647

22463 7590 10/05/2006

EXAMINER

SMART AND BIGGAR  
438 UNIVERSITY AVENUE  
SUITE 1500 BOX 111  
TORONTO, ON M5G2K8  
CANADA

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/825,412 Examiner Joseph E. Avellino	HOOD ET AL. Art Unit 2143

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 21 March 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1.  The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2.  The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3.  At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4.  (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5.  The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi))
6.  The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7.  The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8.  The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9.  The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10.  Other (including any explanation in support of the above items):

See Attached "Order Returning Undocketed Appeal to Examiner" Mailed September 11, 2006 for explanation.

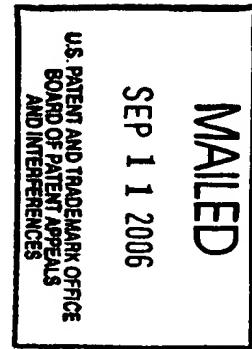
BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte GRANT HOOD AND CRAIG PRIEST

Application 09/825,412



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on June 29, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on March 21, 2006. The Appeal Brief is defective, for it does not fully comply with 37 CFR § 41.37 (c)(1)(v). 37 CFR § 41.37(c)(1)(v) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, six paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See §41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following section are missing from the Appeal Brief filed March 21, 2006:

- 1) "Grounds of Rejection to be Reviewed on Appeal" 37 CFR § 41.37(c)(1)(vi);
- 2) "Evidence Appendix" as set forth in 37 CFR § 41.37(c)(1)(ix);

3) “*Related Proceeding Appendix*” as set forth in 37 CFR § 41.37(c)(1)(x).

It is also noted that appellants’ Summary of Claimed Subject Matter, does not comply with 37 CFR § 41.37(c)(1)(v), for it does not map the independent claims to the specification. Appropriate correction is required.

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board’s new rules, please see the web page entitled “More Information on the Rules of Practice Before the BPAI,” Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

On May 19, 2006, an Examiner’s Answer was entered into the record. In the Evidence Relied Upon section, page no. 3, paragraph 8, the examiner has stated that “No evidence is relied upon by the examiner in the rejection of the claims under appeal.” A review of the file reveals that references to Ziskind et al. 2002/0073343, and Lamb et al. 6,747,970 were applied to the statement of rejections in the Grounds of Rejection, paragraph (9) of the examiner’s answer. Before further review, the examiner must submit a corrected examiner’s answer that will include in the Evidence Relied Upon section, the list of references mentioned in the statement of rejections. See the Manual of Patent Examining Procedure, (MPEP) § 1207.02. Appropriate correction is required.

Accordingly, it is **ORDERED** that the application is returned to the Examiner for:

- 1) hold the Appeal Brief filed on March 21, 2006, defective;
- 2) notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;

- 3) if necessary vacate the Examiner's Answer mailed May 19, 2006, and issue a revised Examiner's Answer having the missing references listed under the Evidence Relied Upon section, paragraph (8); and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:



DALE M. SHAW

Deputy Chief Appeal Administrator  
(571) 272-9797

DMS:kis

CC: SMART AND BIGGAR  
438 UNIVERSITY AVENUE  
SUITE 1500 BOX 111  
TORONTO ON M5G2K-8 CA CANADA